IN THE UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

Acacia Media Technologies Corp.,

Plaintiff,

vs.

New Destiny Internet Group, et al.,

Defendants.

____

And All Related and/or Consolidated Actions.

______________________________________/

NO. C 05-01114

ORDER RE: MOTIONS FOR RECONSIDERATION OF CLAIM CONSTRUCTION ORDER; FIFTH CLAIM CONSTRUCTION ORDER

The Court has issued a series of Orders construing the words and phrases of the patents-in-suit. This Order addresses motions for reconsideration of several phrases.

I. STANDARDS

During the process of this litigation, the Court has stated the legal standards upon which it relies for construction of patent claims. The Court recites them here for convenience of reference.

A. General Principles of Claim Construction

Claim construction is a matter of law, to be decided exclusively by the Court. Markman v. Westview Instruments, Inc., 517 U.S. 370, 387 (1996). When the meaning of a term used in a claim is in dispute, the Court invites the parties to submit their respective proposed definitions and a brief, outlining the basis for their proposals. In addition, the Court conducts a hearing to allow oral argument of the respective proposed definitions. After the hearing, the Court takes the matter under

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submission, and issues an Order construing the meaning of the term. The Court's construction becomes the legally operative meaning of the term that governs further proceedings in the case. Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996). The Court recognizes that claim construction is a fluid process, wherein the Court may consider a number of extrinsic sources of evidence so long as they do not contradict the intrinsic evidence. However, the Court acknowledges that greater weight should always be given to the intrinsic evidence. Phillips v. AWH Corp., 415 F.3d 1303, 1324 (Fed. Cir. 2005).

B. Construction from the View Point of an Ordinarily Skilled Artisan

A patent's claims define the scope of the patent: the invention that the patentee may exclude others from practicing. Id. at 1312. The Court generally gives the patent's claims their ordinary and customary meaning. In construing the ordinary and customary meaning of a patent claim, the Court does so from the viewpoint of a person of ordinary skill in the art at the time of the invention, which is considered to be the effective filing date of the patent application. Thus, the Court seeks to construe the patent claim in accordance with what a person of ordinary skill in the art would have understood the claim to have meant at the time the patent application was filed. This inquiry forms an objective baseline from which the Court begins its claim construction. Id.

The Court proceeds from that baseline under the premise that a person of ordinary skill in the art would interpret claim language not only in the context of the particular claim in which the language appears, but also in the context of the entire patent specification, of which it is a part. Id. at 1313. Additionally, a person of ordinary skill in the art would consult the rest of the intrinsic record, including any surrounding claims, the drawings, and the prosecution history—if it is in evidence. Id.; Teleflex, Inc. v. Fisosa N. Am. Corp., 299 F.3d 1313, 1324 (Fed. Cir. 2002). In reading the intrinsic evidence, a person of ordinary skill in the art would give consideration to whether the disputed term is a term commonly used in lay language, a technical term, or a term defined by the patentee.

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C. Commonly Used Terms

In some cases, disputed claim language involves a commonly understood term that is readily apparent to the Court. In such a case, the Court considers that a person of ordinary skill in the art would give to it its widely accepted meaning, unless a specialized definition is stated in the patent specification or was stated by the patentee during prosecution of the patent. In articulating the widely accepted meaning of such a term, the Court may consult a general purpose dictionary. Phillips, 415 F.3d at 1314.

D. Technical Terms

If a disputed term is a technical term in the field of the invention, the Court considers that one of skill in the art would give the term its ordinary and customary meaning in that technical field, unless a specialized definition is stated in the specification or during prosecution of the patent. In arriving at this definition, the Court may consult a technical art-specific dictionary or invite the parties to present testimony from experts in the field on the ordinary and customary definition of the technical term at the time of the invention. Id.

E. Defined Terms

The Court acknowledges that a patentee is free to act as his or her own lexicographer. Acting as such, the patentee may use a term differently than a person of ordinary skill in the art would understand it, without the benefit of the patentee's definition. Vitronics Corp., 90 F.3d at 1582. Thus, the Court examines the claims and the intrinsic evidence to determine if the patentee used a term with a specialized meaning.

The Court regards a specialized definition of a term stated in the specification as highly persuasive of the meaning of the term as it is used in a claim. Phillips, 415 F.3d at 1316-17. However, the definition must be stated in a clear words, which make it apparent to the Court that the term has been defined. See id.; Vitronics Corp., 90 F.3d at 1582. If the definition is not clearly stated or cannot be reasonably inferred, the Court may decline to construe the term pending further proceedings. Statements made by the patentee in the prosecution of the patent application as to the scope of the invention may be considered when deciding the meaning of the claims. Microsoft

Corp. v. Multi-Tech Systems, Inc., 357 F.3d 1340, 1349 (2004). Accordingly, the Court may also examine the prosecution history of the patent when considering whether to construe the claim term as having a specialized definition.

In construing claims, it is for the Court to determine the terms that require construction and those that do not. See U.S. Surgical Corp. v. Ethicon, Inc.,103 F.3d 1554, 1568 (Fed. Cir. 1997). Moreover, the Court is not required to adopt a construction of a term, even if the parties have stipulated to it. Pfizer, Inc. v. Teva Pharmaceuticals, USA, Inc., 429 F.3d 1364, 1376 (Fed. Cir. 2005). Instead, the Court may arrive at its own constructions of claim terms, which may differ from the constructions proposed by the parties.

In addition to the authorities cited in this Order, the Court will apply the legal standards recited in its previous Claim Construction Orders.

II. DISCUSSION

A. The '992 Patent

1. "transmission system"

Plaintiff moves the Court to reconsider the subsisting definition of the phrase "transmission system"[1] as it is used in Claims 19 and 41.

Claim 19 of the '992 Patent provides:[2]

> A distribution method responsive to requests from a user identifying items in **a transmission system containing information** to be sent **from the transmission system** to receiving systems at remote locations, the method comprising the steps of:

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[1] In its Third Claim Construction Order dated December 14, 2006, the Court construed the phrase "transmission system" as a coined phrase meaning:

> An apparatus which comprises the following interconnected components: a source material library means, an identification encoding means, a conversion means, an ordering means, a compression means, a compressed data storing means (as illustrated in the block diagram labeled Figure 2a), and a compressed data storage means and a transmitter means (as illustrated in the block diagram labeled Figure 2b). The corresponding structure for each means is the structure identified in the specification for performing the recited function.

(Third Claim Construction Order at 8, hereafter, "Third Markman," Docket Item No. 216.)

[2] Unless otherwise indicated, all bold typeface is added by the Court to emphasize the terms and phrases under consideration.

storing, in the transmission system, information from items in a compressed data form, the information including an identification code and being placed into ordered data blocks;

sending a request, by the user **to the transmission system**, for at least a part of the stored information to be transmitted to one of the receiving systems at one of the remote location selected by the user;

sending at least a portion of the stored information **from the transmission system** to the receiving system at the selected remote location;

receiving the sent information by the receiving system at the selected remote location;

storing a complete copy of the received information in the receiving system at the selected remote location; and

playing back the stored copy of the information using the receiving system at the selected remote location at a time requested by the user.

Claim 41 of the '992 atent provides:

A method of transmitting information to remote locations, the transmission method comprising the steps, **performed by a transmission system**, of:

storing items having information in a source material library;

retrieving the information in the items from the source material library;

assigning a unique identification code to the retrieved information;

placing the retrieved information into a predetermined format as formatted data;

placing the formatted data into a sequence of addressable data blocks;

compressing the formatted and sequenced data blocks;

storing, as a file, the compressed, formatted, and sequenced data blocks with the assigned unique identification code; and

sending at least a portion of the file to one of the remote locations.

Since the elements of Claims 19 and 41 require that a step of the patented process be performed on, with or by[3] a "transmission system, the Court has ruled that "transmission system" is a limitation in those elements and must be construed.

The Court begins its consideration of the meaning of "transmission system" as it is used in method Claims 19 and 41, with the recognition that the phrase is used in other claims of the '992 Patent. The subject matter of the '992 Patent is an "Audio and Video Transmission System." The '992 Patent contains numerous independent and dependent claims to a device called a "transmission system." (See e.g., Claims 1-18; 47-53). In addition, the '992 Patent contains numerous process or method claims. (See e.g., Claims 19-24; 41-46; 54-58). Each of the method claims is a new and useful process which is performed on, with, or by the patented "transmission system."[4]

The Court affirms its previous finding that the inventors gave a specialized meaning to the phrase "transmission system." The claims disclose a system which does more than "transmit." In construing both the apparatus and method claims, the Court has determined that the phrase "transmission system" was coined by the inventors to describe a system which stores physical items, extracts information from those items, encodes the information, processes and categorizes it and then stores the information in a form and location accessible to users. In addition, upon request from a user, the "transmission system" transmits information to a remote "receiving system" selected by a user. Thus, the Court has determined that "transmission system" must be construed in a way which recognizes its multiple features and functions.

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[3] A method in which an apparatus is "used" to perform a function, is different from a method "performed by" an apparatus. In Claims 19 and 41, the "transmission system" is both "used" to perform the method and, itself "performs" some of the steps. Claim 19 recites as a step: "sending a request, by the user to the transmission system. . ." Inherently, in this step, the user is employing or "using" the transmission system as a device to receive the user's request. It is clear from the language of Claims 19 and 41 that the "transmission system" also performs steps to fulfill the purpose of the method.

[4] The '992 Patent repeats the same pattern for a patented apparatus called "receiving system." Claims 25-40 are apparatus claims. Claims 54-58 are method claims which recite steps performed "at the receiving system."

In the written description and drawings, the inventors describe an embodiment of the "transmission system" and "reception system" which enable them to perform the steps of the claims. As to the "transmission system," the written description provides:

> To achieve the objects in accordance with the purposes of the present invention, as embodies and described herein, the **transmission . . . system for providing information to remote locations comprises** source material library means prior to identification and compression; identification encoding means for retrieving the information for the items from the source material library means and for assigning a unique identification code to the retrieved information; conversion means, coupled to identification encoding means, for placing the retrieved information into a predetermined format as formatted data; ordering means, coupled to the conversion means, for placing the formatted data into a sequence of addressable data blocks; compression means, coupled to the ordering means, for compressing the formatted and sequenced data; compressed data storing means, coupled to the compression means, for storing as a file the compressed sequenced data received from the compression means with the unique identification code assigned by the identification encoding means; and transmitter means, coupled to the compressed data storing means, for sending at least portion of a specific file to a specific one of the remote locations.

('992 Patent, Col. 2:25-48.)

The specification discusses the function of the enumerated "means." In some instances the specification describes a known device for performing an enumerated function. For example, the specification describes an: "analog-to-digital converter,"[5] "digital telecine device,"[6] "time encoder,"[7] "apt-s 100 digital audio compression system, manufactured by Audio Porcessing Technology."[8] In other instances, the specification describes the function of a "means" but does not further describe whether the function is performed by hardware, software or a combination.

In the Third Claim Construction Oder, the Court incorporated the "means" nomenclature in defining the components of the "transmission system" of the invention. Plaintiff now seeks clarification as to whether the Court is defining the phrase "transmission system" under §112 ¶ 6.

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[5] '992 Patent, Col. 7:14.

[6] '992 Patent, Col. 7:38.

[7] '992 Patent, Col. 7:63.

[8] '992 Patent, Col. 9:61-64.

In addition, the Court is asked to reconsider including an enumeration of components in its construction.

Upon reconsideration, the Court finds it necessary to modify its construction. First, the Court clarifies its incorporation of the word "means" in its discussion of "transmission system." Second, the Court clarifies its construction of the phrase "transmission system" and discusses the components of "transmission system" which are necessary to perform the methods claimed in Claims 19 and 41.

a. The use of the word "means" in the specification to identify the components of the patented "transmission system" does not invoke § 112 ¶ 6

In the written description, the inventors describe their "transmission system" and enumerate its components. In naming each component, the inventors use the tag word "means" to signify a physical component or a group of components. To distinguish one component "means" from another, each component "means" is preceded by a modifier: "**source material library** means;" "**identification encoding** means;" "**conversion** means;" "**ordering** means;" "**compression** means;" "**compressed data storing** means;" and "**transmitter** means." In its discussion of the various components of the "transmission system," the Court incorporated the inventors' "means" phraseology in its construction. (See Third Markman at 7.) Although, the Court incorporated the inventors' tag word "means," the Court now finds that the claim construction under § 112 ¶ 6 is inappropriate because neither Claims 19 nor Claim 41 contain means-plus-function or step-plus-function claim elements.[9]

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[9] "Means-plus-function" claim construction is invoked in a case in which the Court is called upon to construe a patent claim to an apparatus (or method), in which an element of the claim is written in "means-plus-function" format. When construing a claim limitation that is written in "means-plus-function" format, the Court first must identify the function of the claim limitation and then it must consult the specification to attempt to identify the corresponding structure which performs that function. If the specification discloses a structure, and clearly links that structure to the function recited in the claim, the Court would construe the element as limited to the identified structure and its equivalents. See Micro Chemical, Inc. v. Great Plains Chemical Co., Inc., 194 F.3d 1250, 1258 (Fed. Cir. 1999).

b. The phrase "transmission system" means the patented apparatus described in the specification, including its inherent interoperability

Both Claims 19 and 41 disclose a structure, i.e., a "transmission system" which is used to perform the method.[10] Since the claims require that a step be performed by or with a transmission system," it becomes necessary to define the phrase. Specifically, the parties request clarification whether the Court's construction of "transmission system" means the entire "transmission system" (i.e., all enumerated components in the specification) or whether the definition of the phrase is to be modified as to each method claim depending upon the steps of the method.

As a matter of law, if in the preamble or in steps of a method claim the inventors specify that the method is performed by or with a particular apparatus, the disclosed apparatus is a limitation of the claim. Bell Communication Research, Inc. v. Vitalink Communications Corp., 55 F.3d 615, 619 (Fed. Cir. 1995).

In this case, the Preamble and particular steps of Claims 19 and 41 recite that the method is performed by or with a "transmission system." However, incorporation of the "transmission system" also incorporates the inherent operability of the system, which affects which components are "essential." For example, the written description and the drawings describe three aspects of the "transmission system" which affect which components are essential: (a) cooperative relationship between and among components, (b) optional components and (c) components necessary to respond to or perform the steps of a particular claim. Below, the Court uses the block diagrams and passages of the written description to illustrate how these aspects affect the claim construction.

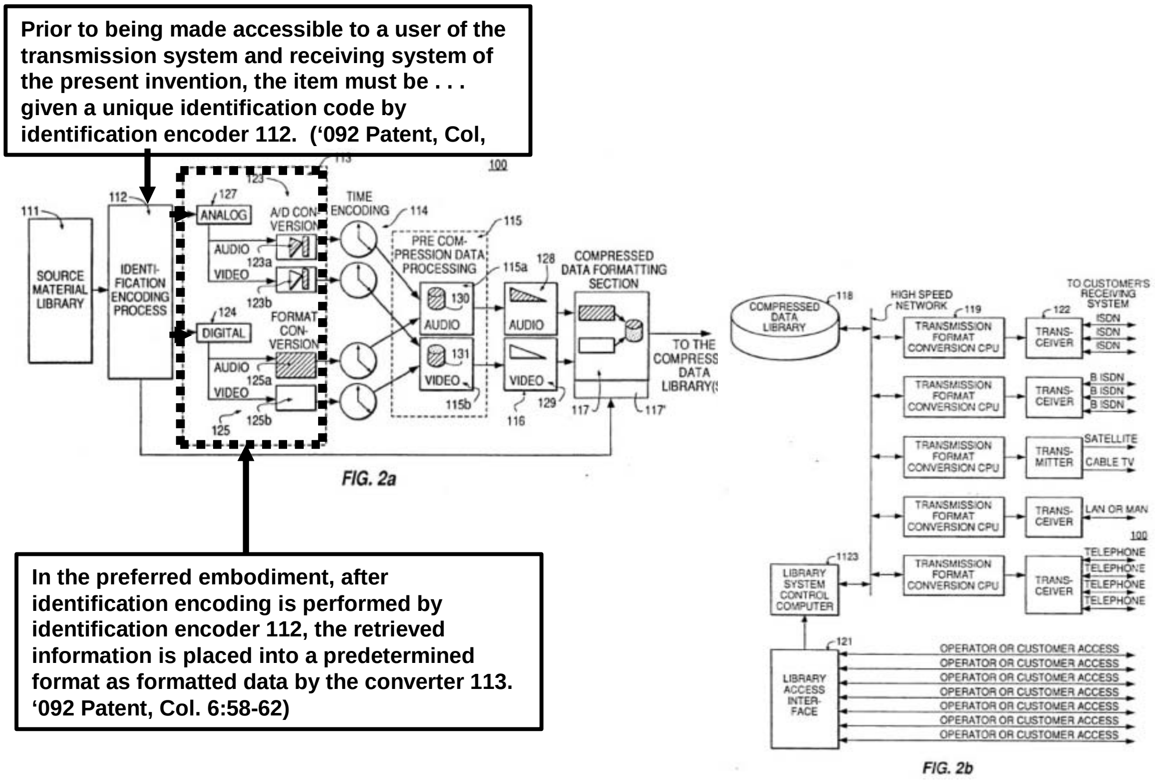
i. cooperative relationship between and among the components

In the claims, written description, and the drawings of the '992 Patent, the inventors indicated cooperative relationships between interconnected components of the "transmission system." A person of skill in the art would have understood from the written description and the

[10] Although the Court does not analyze the function of each component in deciding whether to include it in a construction of "transmission system," functionality of a component is not wholly irrelevant. Functionality may be considered to determine if a component is or is not includable to perform the steps of a method. In addition, functionality of a component may be an issue if objections to patentability are raised during post-construction proceedings.

drawings that information flows from one component or set of components to another. For example, the cooperative relationship between the block entitled "Identification Encoding Process" and other components is illustrated below:

ILLUSTRATION OF
COOPERATIVE RELATIONSHIP
BETWEEN COMPONENTS

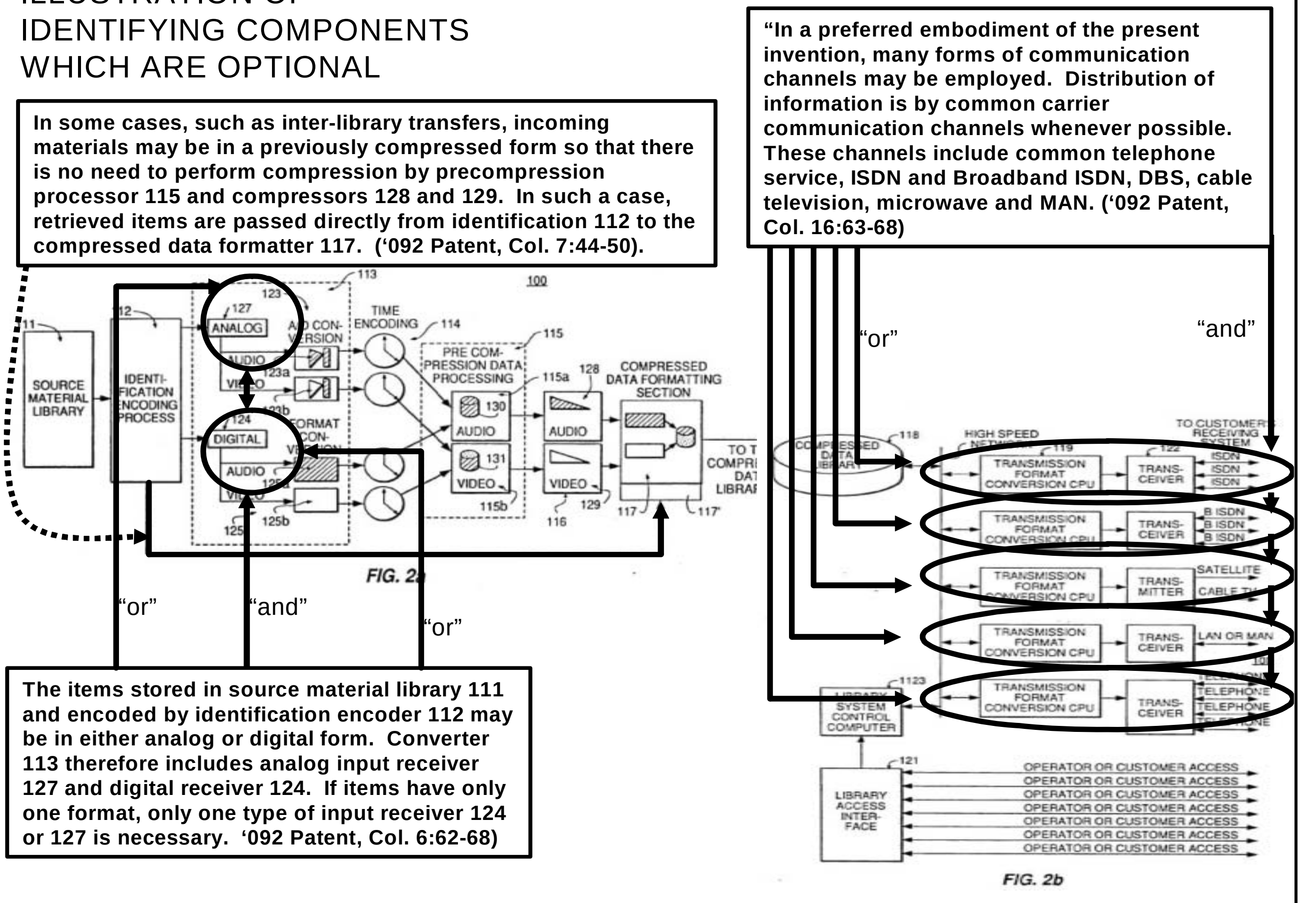

Prior to being made accessible to a user of the transmission system and receiving system of the present invention, the item must be . . . given a unique identification code by identification encoder 112. ('092 Patent, Col,
In the preferred embodiment, after identification encoding is performed by identification encoder 112, the retrieved information is placed into a predetermined format as formatted data by the converter 113. '092 Patent, Col. 6:58-62)
SOURCE MATERIAL LIBRARY
IDENTI-FICATION ENCODING PROCESS
ANALOG
DIGITAL
A/D CONVERSION
FORMAT CONVERSION
TIME ENCODING
PRE COMPRESSION DATA PROCESSING
COMPRESSED DATA FORMATTING SECTION
TO THE COMPRESSED DATA LIBRARY
FIG. 2a
COMPRESSED DATA LIBRARY
HIGH SPEED NETWORK
TRANSMISSION FORMAT CONVERSION CPU
TO CUSTOMER'S RECEIVING SYSTEM
LIBRARY SYSTEM CONTROL COMPUTER
LIBRARY ACCESS INTERFACE
OPERATOR OR CUSTOMER ACCESS
FIG. 2b

Thus, the determination of which components of the "transmission system" are "essential" for a particular claim must take into account the structural and functional relationship between and among components as described in the specification.

ii. optional components

A skilled artisan at the time of the invention would have understood that the inventors devised a "transmission system" which has optional components, depending, for example, upon the nature of the information, the user's request and the type of receiving system which the user selects. The optional nature of the components of the system are illustrated below:

ILLUSTRATION OF IDENTIFYING COMPONENTS WHICH ARE OPTIONAL


In some cases, such as inter-library transfers, incoming materials may be in a previously compressed form so that there is no need to perform compression by precompression processor 115 and compressors 128 and 129. In such a case, retrieved items are passed directly from identification 112 to the compressed data formatter 117. ('092 Patent, Col. 7:44-50).
"In a preferred embodiment of the present invention, many forms of communication channels may be employed. Distribution of information is by common carrier communication channels whenever possible. These channels include common telephone service, ISDN and Broadband ISDN, DBS, cable television, microwave and MAN. ('092 Patent, Col. 16:63-68)
"or"
"and"
SOURCE MATERIAL LIBRARY
IDENTI-FICATION ENCODING PROCESS
ANALOG
DIGITAL
AUDIO
VIDEO
TIME ENCODING
PRE COM-PRESSION DATA PROCESSING
COMPRESSED DATA FORMATTING SECTION
"or"
"and"
"or"
FIG. 2a
HIGH SPEED NETWORK
TO CUSTOMER RECEIVING SYSTEM
TRANSMISSION FORMAT CONVERSION CPU
TRANS-CEIVER
TRANS-MITTER
ISDN
B ISDN
SATELLITE
LAN OR MAN
TELEPHONE
LIBRARY SYSTEM CONTROL COMPUTER
LIBRARY ACCESS INTER-FACE
OPERATOR OR CUSTOMER ACCESS
The items stored in source material library 111 and encoded by identification encoder 112 may be in either analog or digital form. Converter 113 therefore includes analog input receiver 127 and digital receiver 124. If items have only one format, only one type of input receiver 124 or 127 is necessary. '092 Patent, Col. 6:62-68)
FIG. 2b

A skilled artisan at the time of the invention would have understood that the "transmission system" contains components for processing, for example, **digital audio information** which are separate and distinct from those for processing **analog video information**. Similarly, information from the block labeled "Identification Encoding Process" could **optionally** be passed to either Block 113 or to Block 117 or to both, depending upon the nature of the information being processed.

Thus, the determination of which components of the "transmission system" are "essential" is affected by whether the step which is being performed on or with the system is broad or limited in scope.

iii. components necessary to respond to the steps of the claim

To meet the “transmission system” limitation of a step, an apparatus must contain the component or components necessary to perform that step. Below, the Court illustrates components which are responsive to some of the steps of Claim 19:

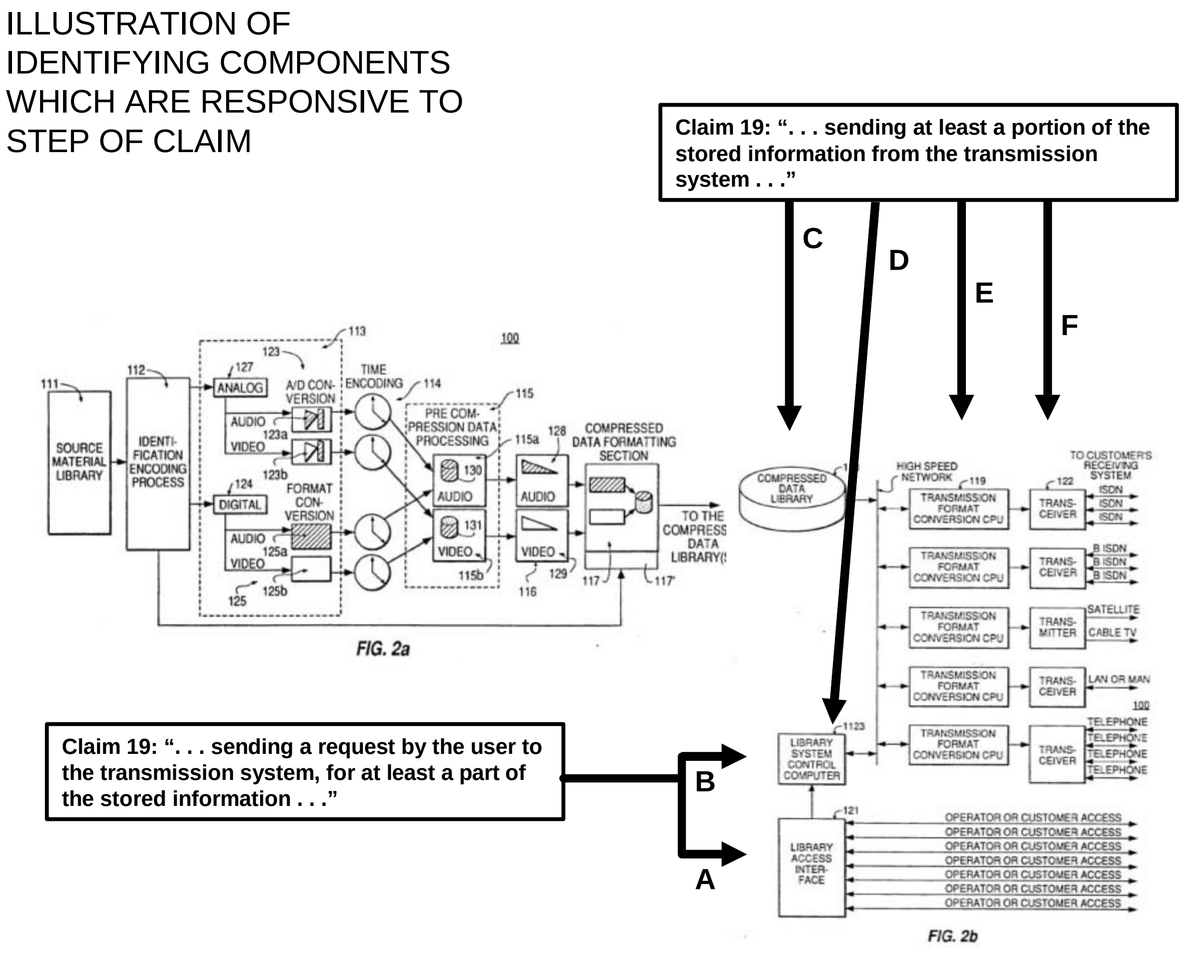


ILLUSTRATION OF IDENTIFYING COMPONENTS WHICH ARE RESPONSIVE TO STEP OF CLAIM
Claim 19: “. . . sending at least a portion of the stored information from the transmission system . . .”
C
D
E
F
Claim 19: “. . . sending a request by the user to the transmission system, for at least a part of the stored information . . .”
B
A
SOURCE MATERIAL LIBRARY
IDENTI-FICATION ENCODING PROCESS
ANALOG
DIGITAL
AUDIO
VIDEO
A/D CON-VERSION
FORMAT CON-VERSION
TIME ENCODING
PRE COM-PRESSION DATA PROCESSING
COMPRESSED DATA FORMATTING SECTION
TO THE COMPRESS DATA LIBRARY(
FIG. 2a
COMPRESSED DATA LIBRARY
HIGH SPEED NETWORK
TRANSMISSION FORMAT CONVERSION CPU
TRANS-CEIVER
TRANS-MITTER
TO CUSTOMER'S RECEIVING SYSTEM
ISDN
B ISDN
SATELLITE
CABLE TV
LAN OR MAN
TELEPHONE
LIBRARY SYSTEM CONTROL COMPUTER
LIBRARY ACCESS INTER-FACE
OPERATOR OR CUSTOMER ACCESS
FIG. 2b

The Third Claim Construction Order’s definition of “transmission system” includes an enumeration of components determined by the Court to be essential. The Court now finds that there are additional components which are essential, depending upon the steps of a particular claim. For example, the current definition omits the components entitled “Library Access Interface” and the “Library System Control Computer,” which are essential to allow the “transmission system” to perform the following step of Claim 19:

> sending a request by the user to the transmission system, for at least a part of the stored information to be transmitted to one of the receiving systems at one of the remote locations selected by the user[.]

Rather than list the "essential" components of a "transmission system" for each method claim, the Court vacates its previous definition. The Court now adopts a definition of "transmission system" which applies to all method claims and which recognizes its inherent interoperability of the system. Accordingly, as used in Claims 19 and 41 of the '992 Patent, the Court now construes the phrase **"transmission system"** to mean:

> **the transmission system of the present invention as described in the specification, comprising all necessary components to perform each step required to be performed by, on, or with a transmission system. With respect to Claim 19, the following components are necessary to perform the following steps:[11]**

b. Request for submission from the parties of enumeration of essential components

As discussed in footnote 11, the Court intends to include in its construction of "transmission system" a description of each component or group of components which is necessary to perform each step of each asserted method claim.[12] However, to avoid further controversy, the Court invites the parties to submit their proposed list of which components are necessary to perform each step. The submitted enumeration must be based on the above construction of the phrase "transmission system" and take into consideration cooperative relationships, optional components and the steps of each claim.

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[11] The Court intends to insert a listing of essential components.

[12] In addition, the issue of which components are essential is deferred until the Court is called upon to determine whether an alleged infringer is using a "transmission system" to perform a step which Claims 19 or 41 require be performed by or on a "transmission system."

The memorandum must be accompanied by a Chart in the following format:

Patent '000 Claim No.	**Patent Claim language**	**Component necessary to perform step**	**Supporting reference(s) from specification**	**Commentary**
'092, Claim 19 step 4	". . .sending at least a portion of the stored information from the transmission system. . ."	Components described in the specification and illustrated by Block Diagram 2b, labeled 118, 119, 122	"In a preferred embodiment of the present invention, many forms of communication channels may be employed. . .('092, Col. 16:63-68)	The Block Diagram shows alternative structures. One or all of them may be necessary depending upon . . . [See Section II in the attached Memorandum of Law]
'092, Claim 19 step 5				
'092, Claim 19 step 6				

2. "receiving system"

The claim construction analysis with respect to "transmission system" applies equally to the phrase "receiving system." Accordingly, the Court vacates its previous construction and now construes the phrase "**receiving system**" as used in Claim 19 of the '992 Patent to mean:

> **the receiving system of the present invention as described in the specification, comprising all necessary components to perform each step required to be performed by, on, or with a receiving system.**

As with "transmission system," the Court intends to include a description of the necessary components in its Claim Construction. The Court invites the parties to submit their proposed list of which components are necessary to perform the steps of Claim 19 on, with or by a "receiving system." The submission must include supporting memorandum and the Chart as outlined above.

3. "sequence of addressable data blocks"

The Court declines to modify its previously construction of the phrase, "sequence of addressable data blocks."

4. "storing"

The Court has been requested to reconsider its construction of the word "storing" as used in Claim 41, which provides:

> A method of transmitting information to remote locations, the transmission method comprising the steps, performed by a transmission system, of:
>
> storing items having information in a source material library;

In the Third Claim Construction Order, the Court construed the phrase "storing items having information in a source material library" to mean "placing physical items containing audio information or video information or both into a collection or original sources of information." (Third Markman at 30.) The Court has been persuaded to reconsider its construction.

Claim 41 recites "storing" items in a source material library as the first step in the process. The Preamble requires that "storing" be "performed by the transmission system." The issue is whether the word "storing" should be construed to mean that the transmission system performs a manipulative step of "placing" items into the source material library, or whether the word should be construed to mean that the transmission system performs the step by "retaining" the items in the source material library. Plaintiff now requests that the Court re-interpret "storing" to mean "retaining." Plaintiff contends that both interpretations are supported by the plain ordinary meaning and use of the word "storing," but that "retaining" is the only interpretation which is supported by the specification.[13]

The words "to store" and "storing" are commonly used words with plain and ordinary meanings. Among others, the act of "storing items" means placing the items in a location."[14] See WEBSTER'S NEW TWENTIETH CENTURY DICTIONARY, 1796 (2d ed. 1983). However, as pointed out by Plaintiff, another interpretation of "storing items" is "retaining items." The "placing" interpretation is appropriate when the phrase "storing items" is being used to describe the act of

[13] During the course of the litigation, Plaintiff has asserted various constructions of the term. Plaintiff is once again asking the Court to construe "storing" to mean "retaining."

[14] For the reasons stated in its Third Claim Construction Order, this was the interpretation used by the Court.

putting the items in a location. The "retaining" interpretation is appropriate when the phrase "storing items" is used to describe holding the items secure or intact in a place or condition.

The process of placing items in a location and retaining items are sufficiently different from each other as to make it important to determine which process was meant by the inventors. In making a determination of which interpretation to adopt, the Court notes that the phrase is used in a step of a method claim. Although it might be subject to limitations, a step in a method claim must be an act performed by an actor on a workpiece:[15]

> A very important rule to remember is that the "elements" of a method claim instead of being structural parts, are, and must be, acts or manipulative steps that are performed upon an article, workpiece or chemical substance.

5 ROBERT C. FABER, LANDIS ON MECHANICS OF PATENT CLAIM DRAFTING, 4-2 (2006).

Either interpretation of "storing items" ("placing" the items in a location or "retaining" the items in a location or condition) is a manipulative step. The Preamble of Claim 41 expressly provides that each step, including the step of "storing" must be performed by the "transmission system." Thus, under either interpretation, in performing the step of "storing" the "transmission system" is acting on a workpiece (items).

Upon reconsideration, the Court has determined that the interpretation of "storing items" to mean "placing items" is problematic because the specification does not contain any description of how the transmission system places items into the system. On the other hand, a person of skill in the art reading the specification at the time of the invention, might find support in the specification for interpreting "storing items" to mean "retaining items,"[16] because the specification discloses a component of the "transmission system," i.e., the "source material library" as a component which holds items. Thus, there is a basis for a skilled artisan to determine that when the inventors claimed a process in which the "transmission system" performs the step of "storing items having information in a source material library," the inventors might have meant that the "transmission system" was "retaining the items" in the source material library. At this point, the Court does not decide nor does Plaintiff point out what disclosed features of the "transmission system" enable it to perform "retaining" activity.[17] The Court leaves enablement or definiteness for consideration later if a motion addressing the issue is brought before the Court.

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[15] Plaintiff objects to this proposition. To support its position that elements of process claims need not be manipulative steps, Plaintiff contends that the step of "leaving" baked goods in an oven is not manipulative. The Court rejects Plaintiff's hypothetical as illustrative of non-manipulative conduct. A manipulative step is a step in a process performed by an actor upon a workpiece. If the actor in Plaintiff's hypothetical "leaves" an item in a oven for a period of time during the baking process, active conduct is being performed.

[16] When possible claim language should be construed to preserve validity of the claim. See Texas Instruments v. U.S. International Trade Commission, 871 F.2d 1054 (Fed. Cir. 1989).

Accordingly, the Court vacates its construction of the phrase "storing items having information" in its Third Claim Construction Order.

The Court now construes the phrase "storing items having information" to mean:

> **an act performed by the "transmission system" of retaining physical items containing audio information or video information or both as a collection of original sources of information in the source material library.**

B. Additional Briefing Regarding Claim 45 of the '992 Patent

In the Third Claim Construction Order, the Court declined to construe the meaning of the phrase "separately storing a plurality of files" as it is used in dependent Claim 45 of the '992 Patent. In their memorandum regarding the present motions, the parties have addressed the Court's declination to construe Claim 45. However, no formal motion is made by either party with respect to the matter. Accordingly, the Court declines to take any action with respect to Claim 45 at this time.

C. Disposition of Pending Motions

Previously, Plaintiff filed a Motion for Entry of Judgment of Non-Infringement and Invalidity for Indefiniteness of U.S. Patent No. 6,144,702 and for Certification Pursuant to Federal Rule of Civil Procedure 54(b) in which Defendants opposed. (See Docket Item Nos. 121, 133.) Since the motion was made prior to completion of claim construction, it is DENIED without prejudice to being renewed upon completion of claim construction.

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[17] The specification is silent as to what component of the "transmission system" is capable of performing the "retaining" step. With respect to storing physical items having information, the only component discussed in the specification is the "source material library" itself. However, the "source material library" is only described as containing a collection of items having information. See e.g., '992 Patent, Col. 6:8-22.

In addition, Defendants Comcast Cable Communications, LLC and Insight Communications, Inc. filed a Motion for Partial Summary Judgment of Invalidity and Non-Infringement of all Claims of the '702 Patent. (See Docket No. 149). Since the motion was made prior to completion of claim construction, it is DENIED without prejudice to being renewed upon completion of claim construction.

III. CONCLUSION

In this Order, the Court has confirmed, vacated and modified its previous constructions. The Court has also indicated that it intends to modify its construction of the phrases "transmission system" and "receiving system" by adding components that are necessary to perform each step. Any party wishing to submit a proposed construction shall file their memorandum as described in this Order by **November 2, 2007**.

Dated: October 19, 2007

JAMES WARE
United States District Judge

THIS IS TO CERTIFY THAT COPIES OF THIS ORDER HAVE BEEN DELIVERED TO:

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Dated: October 19, 2007

Richard W. Wieking, Clerk

By: /s/ JW Chambers
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